

### **REMARKS**

Applicants respectfully request reconsideration and allowance in view of the foregoing amendment and the following remarks. Applicants amend claims 27 and 43 without prejudice or disclaimer.

#### **Rejection of Claims 27-28, 30, 32-47, and 50-57 Under 35 U.S.C. §103(a)**

The Office Action rejects claims 27-28, 30, 32-47, and 50-57 under 35 U.S.C. §103(a) as being unpatentable over Smirnov et al. (U.S. Patent No. 6,321,133) ("Smirnov et al.") and further in view of Jenney (U.S. Patent No. 6,349,335) ("Jenney"). Applicants traverse this rejection for at least the following reasons. First, Applicants submit that Smirnov et al. is not analogous to the present invention and is therefore unavailable as prior art. Second, Applicants submit that it would not have been obvious to combine Smirnov et al. with Jenney because their combination would require modifications to the prior art structure to accommodate the combination. Furthermore, in order to strengthen the distinction between the claims and the cited art, Applicants amend claim 27 to explicitly recite that the provisioning model is a communication service provisioning model.

First, Applicants explain why Smirnov et al. is not analogous to the present invention and is therefore unavailable as prior art. To rely on a reference under 35 U.S.C. §103, the reference must be analogous prior art. While Patent Office classification of references and the cross-references in the official search notes of the class definitions are some evidence of "nonanalogy" or "analogy" respectively, the court has found "the similarities and differences in structure and function of the inventions to carry far greater weight." *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973). MPEP 2141.01(a). Further, see *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993), where the patent claims were

directed to single in-line memory modules (SIMMs) for installation on a printed circuit motherboard for use in personal computers. The reference to a SIMM for an industrial controller was not necessarily in the same field of endeavor as the claimed subject matter merely because it related to memories. The reference was found to be in a different field of endeavor because it involved memory circuits in which modules of varying sizes may be added or replaced, whereas the claimed invention involved compact modular memories. Furthermore, since memory modules of the claims at issue were intended for personal computers and used dynamic random-access-memories, whereas reference SIMM was developed for use in large industrial machine controllers and only taught the use of static random-access-memories or read-only-memories, the finding that the reference was nonanalogous was supported by substantial evidence.

The field of the present invention is provisioning communication services. Applicants amend claim 1 to make this scope clear in the claim limitations as well as in the preamble. The field of Smirnov et al. is forecasting the first available time for completion of a job request, such as in a manufacturing environment. These fields are very different in structure and function. For example, the structure and function of Smirnov et al. are directed toward manufacturing tangible finished products out of raw materials, forecasting when manufacturing capacity will be available, and order promising of future unscheduled capacity. Smirnov et al., col. 1, line 63 to col. 2, line 11. The present application's structure and function are different from Smirnov et al. because the application relates to providing a service rather than manufacturing a good. The logistics, considerations, and goals of each are very different. For example, Smirnov et al. uses a bill of materials which defines a product structure, i.e. how a product is assembled from its constituent parts. Smirnov et al., col. 6, lines 8-12. The present application is not concerned at all with a physical product or how it is assembled. Rather, provisioning communication services allows a customer to communicate using infrastructure that is already in place, such as telephone

wires, routers, switchboards, and so forth. The structure of provisioning a communication service is very different from forecasting job completion when manufacturing goods.

The physical manufacturing approach of Smirnov et al. is shown in FIG. 2. This approach teaches physical processes such as RIPing, printing, binding, and cutting to create a book as an end product. These physical manufacturing processes are very different from a communications network because a communications service provider already has physical objects (network hardware) in place. The service provider does not perform analogous physical processes when provisioning communications services. A service provider does not, for example, measure out a length of wire and run it from a central hub to the customer's house when a customer signs up for telephone service. Rather, the service provider typically manipulates data, accounts, and permissions to allow a customer access to the network infrastructure already in place. The present application is directed to a communications service provider flexibly provisioning non-physical processes to customers including, for example, configuring and creating email accounts, configuring and creating a hosting account, and establishing DHCP. Specification, paragraphs [0003], [0007].

The differences between forecasting manufacturing job completion and provisioning communication services are a parallel to the differences between SIMMs as in *Wang Laboratories*, cited above. The amendment to claim 1 eliminates the ability of Smirnov et al. to be analogous art. Accordingly, Applicants submit that Smirnov et al. is unavailable as a prior art reference.

Second, assuming *arguendo* that Smirnov et al. is analogous art to the present invention, Applicants explain why it would not have been obvious to one of skill in the art to combine Smirnov et al. with Jenney because their combination would require modifications not taught or suggested in the prior art. If proposed modification would render the prior art invention being

modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). MPEP 2143.01(V). Further, the proposed modification or combination of the prior art cannot change the principle of operation of the prior art invention being modified. MPEP 2143.01(VI). The Office Action cites “the purpose of obtaining an indication that a certain process has occurred” as the motivation for combining Smirnov et al. with Jenney. Office Action, page 3. Applicants submit that this line of reasoning regarding obviousness to combine is not persuasive because Jenney does not generate a signal that identifies when a transition occurs. Jenney teaches a method of determining when a computer suddenly becomes non-operational based on the absence of a status signal rather than positively generating a signal that identifies when a transition occurs. Jenney, col. 2, lines 33-46. A combined approach of Jenney and Smirnov et al. would change the principle of operation of Jenney from detecting the absence of a signal to detecting a signal. Alternatively, combining Jenney and Smirnov et al. in the manner proposed in the Office Action would require modifying the monitored computers of Jenney to generate a signal when a transition occurs when the very same computers have suddenly become non-operational. This approach is clearly unworkable and would render Jenney unsatisfactory for its intended purpose because the computers are non-operational at that stage and incapable of reliably generating a signal, if they are able to generate a signal at all.

Further, Jenney teaches sending a signal periodically, such as every 5 minutes. Jenney, col. 9, lines 6-14. A constant periodic signal regardless of whether or not a transition occurred in fact indicates that the signal of Jenney is not intended to notify of transitions. Rather Jenney intends to provide to a server a periodic, positive signal that the computer remains operational. Modifying Jenney to transmit a signal when a transition occurs would destroy an intended purpose of Jenney. Jenney further teaches that if the computer is sending out a status signal

every five minutes, the server will not want to check every two or three minutes for the status signal because then the status signal would always be late and an unnecessary alert may be generated. Jenney, col. 9, lines 55-61. The server of Jenney periodically checks for expected status signals and can generate an “unnecessary alert” if it checks for signals which are not present. Altering the server of Jenney to accept spontaneous, unexpected signals which indicate transitions would destroy the intended purpose of Jenney of determining the operational status of a computer. Applicants submit that it would not have been obvious to one of skill in the art to combine Smirnov et al. with Jenney in the manner proposed in the Office Action.

Finally, even if combined, the references do not teach or suggest communications services provisioning. Jenney is directed to monitoring the status of computers and Smirnov et al. is directed to order promising for manufacturing physical goods. Accordingly, Applicants submit that claim 27 is patentable over the cited references and is in condition for allowance because the Jenney is non-analogous art and because Jenney and Smirnov et al. do not teach all the limitations of claim 27 even if combined. Applicants further submit that claims 28, 30, and 32-42 are patentable inasmuch as they depend from claim 27 and inherit the same limitations.

Applicants further submit that claim 43 is patentable for the same reasons as claim 27 and claims 44-47 and 50-57 are patentable inasmuch as they depend from claim 43 and inherit the same limitations. Applicants respectfully request that the 35 U.S.C. §103(a) rejection be withdrawn.

**Rejection of Claims 29, 31, 48, and 49 Under 35 U.S.C. §103(a)**

The Office Action rejects claims 29, 31, 48, and 49 under 35 U.S.C. §103(a) as being unpatentable over Smirnov et al. in view of Jenney, and further in view of Leymann et al. (U.S. Patent No. 6,631,354) (“Leymann et al.”). Applicants traverse this rejection and reserve the right


to argue against the combination of Smirnov et al., Jenney, and Leymann et al. at a later date. However such arguments are not necessary at this time because Applicants submit that claims 29 and 31 are patentable over Smirnov et al., Jenney, and Leymann et al. because they depend from claim 27 which is patentable as described above. Applicants further submit that claims 48 and 49 are patentable over Smirnov et al., Jenney, and Leymann et al. because they depend from claim 43 which is patentable as described above. Applicants respectfully request that the 35 U.S.C. §103(a) rejection be withdrawn.

**CONCLUSION**

Having addressed all rejections and objections, Applicants respectfully submit that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited. If necessary, the Commissioner for Patents is authorized to charge or credit the **Novak, Druce & Quigg, LLP, Account No. 14-1437** for any deficiency or overpayment.

Respectfully submitted,

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